

REMARKS

In the parent of this Continuation application, i.e., U.S. patent application S/N 08/850,520, Claims 1, 2, 4, 8, 9, 11 and 13-24 were finally rejected on March 24, 2000 (Paper No. 14) as being unpatentable under 35 U.S.C. 103(a). A response to the final rejection (Paper No. 15) was filed on August 14, 2000, in which it was argued that all pending claims were indeed patentable. In reply to the Applicants' response, an Advisory Action (Paper No. 16) was issued on August 24, 2000, in which it was stated that the Applicants' request for reconsideration of the finality of the rejection of the previous Office Action was persuasive and, therefore, the finality of that action was withdrawn.

The Examiner subsequently indicated in a telephone conference with the Applicants' undersigned representative that Claims 21-24 were allowable, and that Claims 1 and 8 would be allowable if amended to incorporate the features of Claims 13 and 17, respectively. To expedite the allowance of the parent application with the claims indicated to be allowable, the Applicants agreed to incorporate the limitations of Claim 13 into Claim 1, and those of Claim 17 into Claim 8. As a result, Claims 1, 2, 8, 9, 14, 15, 19 and 20 were amended via an Examiner's Amendment; and those claims were allowed along with Claims 4, 11 and 21-24.

However, Applicants continue to believe that all pending claims as they stood prior to the above noted final rejection are patentably distinguishable from the prior art.

Accordingly, by the present Preliminary Amendment, new Claims 13-20 are added to replace originally filed Claims 1-12, the former of which correspond to Claims 1, 2, 4, 16, 8, 9, 11 and 18 of the parent application as they stood prior to the above-noted Examiner's

amendment. The patentability of new Claims 13-20 is discussed hereafter.

The §103 Rejection of Claims 13-20

In the above noted final rejection, Claims 13-20 (as renumbered herein) were rejected under 35 U.S.C. 103(a) over U.S. Patent No. 5,616,876 ("Cluts") in view of U.S. Patent No. 5,583,763 ("Atcheson") and further in view of either U.S. Patent No. 5,499,046 ("Schiller"), U.S. Patent No. 5,819,160 ("Foladare") or U.S. Patent No. 5,892,915 ("Duso"). Applicants respectfully submit that all pending claims are patentably distinguishable over the cited references for at least the reasons set forth below.

Beginning with Claim 13, it is submitted that any proper combination of Cluts and Atcheson with Schiller, Foladare or Duso does not result in a system for accessing, over a wide area network, multimedia equipment for reproducing multimedia information recorded on data storage media, that includes at least the following element:

"generating means for generating a list of contents of multimedia information recorded on data storage media of a first user at a first equipment location, said list of contents being transferred via said wide area network to a second user at a second equipment location, said second user modifying the generated list of contents by selecting items from said list of contents and rearranging the selected items to produce a rearranged list of contents" (italics added for emphasis).

As explained in Applicants' previous Amendments in the parent application, an important aspect of the present invention is the generation of a list of contents of multimedia information recorded on data storage media of a first user, and, the rearrangement of this list of contents, remotely over a wide area network, by a second user. It is submitted that the rearrangement concept by a second user is completely absent from the prior art references relied upon by the

Examiner, as will be explained below.

Further, none of the cited references relates to generating a list of contents of multimedia information recorded on data storage media of a first user, and subsequently controlling multimedia equipment (of the first user) so as to reproduce the multimedia information recorded on the first user's storage media in accordance with a rearranged list. To this end, the Office Action stated on page 3 that Cluts discloses the generating means, in that "Cluts teaches a playlist that is generated for the subscriber by the service provider or publisher", referring to Fig. 4 and col. 12, lines 40-64. This position is respectfully traversed. The system in Cluts is an audio on demand system that has nothing to do with a user's existing data storage media. In the Cluts system, an interactive network *provides music to subscribers*. (See abstract.) That is, unlike the invention of Claim 13, the subscribers are not already in possession of the recorded multimedia information to be subsequently reproduced in accordance with a rearranged list. Referring specifically to Fig. 4 and col. 12 of Cluts, what is disclosed is a screen display in the audio on demand system. Buttons on the screen enable the subscriber to select individual songs, to select a playlist, or to build his own playlist. However, these songs are not already recorded on data storage media of the user; rather, they are stored at the service provider facilities. See, e.g., FIG. 1, and col. 7, lines 2-7, which reveal that the music is stored on memory storage device 30 located at the headend system, not at the consumer system 14. Accordingly, Cluts does not disclose the generating means of Claim 13. Nor do any of the other cited references relate to this feature. Atcheson, for instance, likewise relates to a system for downloading music to subscribers based on their selections from a menu, not to controlling reproduction of multimedia information

already recorded on a user's storage media. See e.g., col. 3, lines 51-63 of Atcheson.

Turning now to the list rearrangement feature, the Office Action recognizes on Page 4 that the combination of Cluts and Atcheson "does not explicitly disclose a second user modifying the generated list [of contents of multimedia information of the first user]". The Applicants agree. Both Cluts and Atcheson disclose systems that generate lists of new information, as opposed to rearranging an existing list of multimedia contents. Accordingly, any proper combination of Cluts and Atcheson would result in a system that lacks this feature of Claim 13.

Schiller does not cure the deficiencies of Cluts and Atcheson with respect to Claim 13. The Office Action states that "Schiller discloses a second user modifying the generated list." Applicants respectfully disagree. There is no second user in Schiller that modifies a generated list of a first user by rearranging its contents. Schiller relates to a cable television system including a plurality of headends. Each headend outputs different video/audio programs to subscribers via a plurality of channels. Each channel is assigned to a particular company (such as HBO). The playlist for each channel is generated and modified by a separate scheduling computer at a location remote from the headend. Thus a company can control the programs, scheduling, etc. of its assigned channel from a remote location.

Assuming that a particular company, "company A", is considered a first user that supplies a generated list of program contents, it is clear that whatever editing of company A's list that takes place *occurs under the remote control of company A itself*, not by a second user. Thus, that actual editing may take place at a second location (the headend) under commands generated at a first location (the scheduler location where company A's commands are generated) is irrelevant

to the present invention. Further, even if an operator at the headend location were to act as a substitute for electronics at the headend to perform the actual editing *under the remote commands of the first user*, this procedure would still be irrelevant to Applicants' invention. Such an operator would not be a "second user" – he would merely serve as a tool for carrying out the instructions of the first user. That is, the operator would not be "*selecting* items from said list of contents and rearranging the selected items" – rather, the *first* user would be performing the selection, and the operator would merely be acting as an extension of the first user. Finally, no such operator at the headend location is even disclosed in the Schiller patent.

Moreover, the Schiller system is irrelevant to the present invention for another reason. Whatever edited list of contents, if any, is generated in the Schiller system, it is not converted into a command for controlling the multimedia equipment *of the first user*. Instead, Schiller's playlist controls programs that are *broadcast to other subscribers*. Thus Schiller's system does not even remotely relate to a system that includes converting means for converting a rearranged list to at least one command for controlling multimedia equipment of a first user (e.g., subscriber), or controlling means for controlling the multimedia equipment based on the command, as in Applicants' Claim 13.

In addition, the Schiller reference cannot be properly combined with Cluts and/or Atcheson. There is no suggestion in the prior art, nor any reasonable reason as to why or how a person skilled in the art could modify the system of Cluts or Atcheson in light of the teachings of Schiller in any way. To this end, the Examiner states in paragraph 10 that "it would have been obvious ... to have incorporated Schiller's teachings of CATV distribution system with the

teachings of Cluts-Atcheson, for the purpose of allowing different companies controlling the output of particular CATV channels to generate, edit, and modify the playlist schedules of their respective channels from locations of their choosing". In response, it is submitted that the above reasoning is misguided. Each company in Schiller is in control of its own programming schedule of its own channel, which is broadcast to many subscribers. The Examiner has not provided any rationale as to why a skilled artisan would be motivated to incorporate Schiller's teachings into the Cluts/Atcheson systems, *or how* this could be done. Indeed, the skilled artisan who was familiar with the Cluts and Atcheson patents, after having read the Schiller patent, would not understand how to modify Cluts/Atcheson. Cluts and Atcheson each relate to a system in which *a subscriber* is able to remotely obtain new song information from a central center. The Schiller invention, on the other hand, merely relates to facilitating remote access of headend equipment *by the service provider*. Thus, the skilled artisan would not be inclined to combine Schiller in any way with Cluts or Atcheson. Indeed, even if the service provider equipment of Cluts or Atcheson could be modified by allowing for remote control by the service provider, such a modification would be irrelevant to Applicant's claimed invention. Any such combination would still lack the feature of *a second user rearranging a list of contents of multimedia information of a first user*.

Accordingly, for at least the above reasons, any proper combination of Cluts, Atcheson and Schiller would still lack several essential features of Claim 13. Thus, Claim 13 is not rendered obvious by these references under §103.

Referring now to the Foladare patent, Foladare likewise does not cure the deficiencies of Cluts and Atcheson with respect to Claim 13. Foladare relates to a radio subscription system that

enables a subscriber to remotely define and identify one or more playlists, each specifying information content *selected by the subscriber* from a subscription content database. (See abstract; and col. 2, lines 2-5.) Foladare does not disclose or suggest *a second user rearranging a list of contents of a first user*. Each subscriber is always in control of his or her own playlist(s). Also, the Foladare system is not relevant in any way to multimedia information recorded on subscribers' data storage media. That is, Foladare likewise does not disclose either the generating means or the controlling means of Claim 13.

On page 9 of the Office Action, it was stated that "Foladare discloses a second user modifying the generated list". It is contended that this assertion is inaccurate. Each subscriber in Foladare is merely remotely *generating his or her own playlist* by selecting items from a large subscription content database. There is *no second subscriber* in the Foladare disclosure that has anything at all to do with a first subscriber. Accordingly, Foladare is irrelevant to the present invention.

Moreover, Foladare does not even relate to a system in which data storage media of a first user is present at a first equipment location. Foladare relates to a system in which a subscriber can select which songs are to be wirelessly transmitted to the subscriber location from a radio station. Cluts and Atcheson each relate to entirely different systems in which a subscriber is merely provided with information about similar music to subscriber selections, which music can then be downloaded to the subscriber. Consider that in determining obviousness, the court (or Examiner) must imagine itself as one of ordinary skill in the art, remove the benefit of hindsight, and pretend that it has never seen the invention. *Smith Indus. Med. Sys., Inc. v. Vital Signs Inc.*, 4

F, Supp. 2d 746, 750 (N.D. Ill. 1997), *rev'd in part, vacated in part*, 50 USPQ 2d 1641 (Fed. Cir. 1999). After familiarizing itself with the prior art, the court should ask if the invention would have been obvious looking at the invention as a whole. *Id.* In the present case, assuming that a person of ordinary skill in the art had the Cluts, Atcheson and Foladare references in front of him, he would have no idea how to modify the Cluts or Atcheson systems with the teachings of Foladare. Indeed, the skilled artisan would not be motivated in any way to modify the Cluts or Atcheson systems, as Foladare relates to an arrangement and concept unrelated to what Cluts and Atcheson are accomplishing. The Examiner has not explained how the techniques of Foladare's programmable radio subscription system could possibly be incorporated into the Cluts or Atcheson systems, or what would result. In fact, Foladare's technique cannot be incorporated into those systems, with the possible exception of the audio on demand music of Cluts/Atcheson being broadcast to the user wirelessly instead of via dedicated audio on demand lines.

Accordingly, it is manifest that the invention of Claim 13 is patentable over the Cluts, Atcheson and Foladare systems.

Turning now to the §103 rejection of Claim 13 over Cluts, Atcheson and Duso, without admitting that the Duso patent constitutes prior art (Duso's provisional application was filed only a few days before the filing of the present application) it is contended that Duso likewise does not cure the deficiencies of Cluts and Atcheson with respect to Claim 13. The Office Action stated that Duso discloses a second user modifying the generated playlist [of a first user]. Applicants respectfully traverse this position. With the Duso system, the user, i.e., the client, is in control of the generation and the subsequent editing of his own playlist, of which both tasks are performed

through a server. The server is not a second user. There is no second user involved in rearranging a first user's playlist. Col. 44, lines 13-24 and col. 45, lines 10-13 reveal:

"The client first creates a session with a play-list containing a fixed number of entries ... The client application does this by first sending a "create session" command to the video file server ... *The server initially creates the play-list as empty*, and it must be populated with at least one clip before playing of a broadcast session may be started ... The server returns a 'session handle' to the client, to identify the broadcast video session ... the client receives the session handle, and uses it to send one or more 'edit session' commands to the video file server to add one or more clips to the play-list."

From the above passages it is readily apparent that the client creates his or her own playlist and then is allowed to edit the same remotely. As the initial play-list is empty, the client cannot be rearranging a list of contents of another client. Accordingly, the Duso reference is likewise not pertinent to the present invention.

Moreover, Duso does not disclose or suggest the generating means of Claim 13, as the video information is provided by the video file server; it is *not information recorded on storage media of a first user*.

Since any proper combination of Duso with Cluts and Atcheson still does not result in a system including essential features of Claim 1 as just explained, these references do not render Claim 13 obvious under §103.

Independent method Claim 17 is contended to be patentable over the cited references for at least the same reasons discussed above concerning analogous features of Claim 13.

Claims 14-16 and 18-20 are believed patentable based at least upon their respective dependencies from Claims 13 or 17.

IV. Conclusion

In view of the foregoing, entry of this Preliminary Amendment, and the allowance of this application with Claims 13-20 are respectfully requested.

The above statements concerning the disclosure in the cited patents represent the present opinion of Applicants' representative and, in the event that the Examiner disagrees, it is respectfully requested that the Examiner specifically indicate those portions of the patents providing the basis for a contrary view.

In the event that additional cooperation in this case may be helpful to complete its prosecution, the Examiner is cordially invited to contact Applicant's representative at the telephone number written below.

The Commissioner is hereby authorized to charge any insufficient fees or credit any overpayment associated with the above-identified application to Deposit Account No. 50-0320.

Respectfully submitted,

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